

In re Application of Arasmith
Application No. 10/650,118
Amendment and Response to First Office Action
Page 31

REMARKS

The Applicant notes with appreciation the Examiner's thorough review of the application, as evidenced by the Office Action dated September 8, 2005.

PRIORITY

The Applicant filed a Second Preliminary Amendment on or about December 4, 2003, amending the specification to include a corrected cross-reference to related applications. The Applicant notes, however, that the corrected cross-reference did not appear in the published application dated May 19, 2005. A copy of the Second Preliminary Amendment including proof of mailing is attached hereto as Appendix A.

The correct priority claim is listed above, in the amendment to paragraph [0001] of the specification.

The Applicant submits herewith a Corrected Declaration and Power of Attorney for Patent Application signed by the inventor.

AMENDMENTS TO THE SPECIFICATION

The Abstract has been amended to more clearly and succinctly summarize the disclosure.

Paragraph [0001] has been amended to correct the cross-reference to related applications.

Paragraph [0071] has been amended to correct the phrase "is not be limited to" so that it now reads – **is not limited to** –.

Related to the Drawing: The Examiner objected to the Drawing on the grounds that multiple element numbers referred to the "overs" depicted in the figures. Paragraph [0122] has been amended to correct the reference "overs 112" so that it now reads – **overs 11** –. Because this amendment corrects the instance of multiple element numbers in the specification, no amendment to the drawing is required.

In re Application of Arasmith
Application No. 10/650,118
Amendment and Response to First Office Action
Page 32

AMENDMENTS TO THE CLAIMS

Claim Rejections – 35 U.S.C. § 112

The Examiner rejected claims 8, 11, 22, 26, 29, 37, 41, 44, 48 49, 71, and 79 under 35 U.S.C. § 112, ¶ 2, on the grounds that the claims, as written are indefinite.

Claims 8, 26, and 71 have been amended to clarify the references to the “endless path” element. Claim 41 has been canceled.

Claims 11 and 29 have been amended to clarify the antecedent basis of “said fence” by amending the phrase to read – **said fence portion** – and by amending the reference to the intervening claim where the “fence portion” element is recited. Claim 44 has been canceled.

Claims 22, 37, and 79 have been amended to clarify the antecedent basis of “said one or more paddle assemblies” by amending the chain of references back to the intervening claim where the “paddle assemblies” element is recited. For example, claim 22 depends from claim 20, which depends from claim 19; claim 19 has been amended to depend from new claim 80, in which the “one or more paddle assemblies” element is introduced. Similarly, claim 37 depends from claim 35; claim 35 depends from claim 23, in which the “one or more paddle assemblies” element is introduced. Claim 79 depends from claim 77; claim 77 has been amended to depend from new 86, in which the “one or more paddle assemblies” element is introduced.

Claims 48 and 49 have been canceled.

Allowable Subject Matter

The Applicant notes the Examiner’s conclusion that the following claims are objected to as being dependent upon a rejected base claim, but would be allowable if re-written in independent form including all the limitations of the base claim and any intervening claims: 5-7, 9, 10, 12, 15-18, 21, 24, 25, 27, 28, 30, 32-34, 36, 39, 40, 42, 43, 45, 47, 50, 51, 70, 72, 73, 75, 76, and 78.

In re Application of Arasmith
Application No. 10/650,118
Amendment and Response to First Office Action
Page 33

Claim 5. New claim 80 includes the allowable subject matter of dependent claim 5, together with the limitations of its base claim 1. Claims 6-22 have been amended so that they now depend from new claim 80. Accordingly, this claim set (80, 6-22) is in condition for immediate allowance.

Claim 12. New claim 81 includes the allowable subject matter of dependent claim 12, together with the limitations of its base claim 1. Accordingly, new claim 81 is also in condition for immediate allowance.

Claim 15. New claim 82 includes the allowable subject matter of dependent claim 15, together with the limitations of its base claim 1 and intervening claim 14. New dependent claims 83-85 are similar to existing claims 16-18 which recite allowable subject matter. According, the new claim set (82-85) is in condition for immediate allowance.

Claim 24. Because the Examiner indicated that dependent claim 24 would be allowable if re-written to include the limitations of claim 23, claim 23 has been amended to include the limitations in claim 24. Claim 24 is canceled. Claims 25-29 and 31 depend from the amended claim 23. This claim set (23, 25-29, 31) is in condition for immediate allowance.

Claim 30, as amended, includes the allowable subject matter of dependent claim 30, together with the limitations of its base claim 23. Accordingly, amended claim 30 is in condition for immediate allowance.

Claim 32, as amended, includes the allowable subject matter of dependent claim 32, together with the limitations of its base claim 23. Claims 33-37 now depend from the amended claim 32. Accordingly, this claim set (32-37) is in condition for immediate allowance.

Claim 70. New claim 86 includes the allowable subject matter of dependent claim 70, together with the limitations of its base claim 68. New dependent claims 87-88 are similar to existing claim 69. Claims 71-75 and 77-79 have been amended so that they now depend from the new claim 86. This claim set (86, 71-75, 77-79) is in condition for immediate allowance.

Claim 73. New claim 89 includes the allowable subject matter of dependent claim 73, together with the limitations of its base claim 68. New dependent claims 90-91 are similar to

In re Application of Arasmith
Application No. 10/650,118
Amendment and Response to First Office Action
Page 34

claims 74-75. New claim 92 is similar to claim 17. This new claim set (89-92) is in condition for immediate allowance.

In summary, the allowable subject matter now appears in the following claim sets, which are in condition for immediate allowance:

Independent Claim	Dependent Claims
80	6-22
81	—
82	83-85
23	25-29, 31
30	—
32	33-37
86	87, 88, 71-75, 77-79
89	90-92

Claim Rejections — 35 U.S.C. § 102

The Examiner rejected claims 1, 2, 3, 13, 68, and 69 under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent 5,413,286 issued to *Bateman*.

After the amendments described above, claim sets 1-5 and 68-70 remain pending in their original form without amendment.

As provided in Section 2131 of the MPEP: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

In re Application of Arasmith
Application No. 10/650,118
Amendment and Response to First Office Action
Page 35

With regard to independent claims 1 and 68, no topper assembly is disclosed in *Bateman*, either expressly or inherently, so the rejection is unsupported by the cited art and should be withdrawn. Claim 1 recites:

“a topper assembly positioned proximate said feeder path, said topper assembly located upstream of said saw assembly relative to said feeder path, said topper assembly configured to reduce the height of said flow of said wood chips such that said flow of wood chips does not tend to extend into said shaft interference zone;”

Claim 68 recites:

“positioning a topper assembly positioned proximate said feeder path, said topper assembly located upstream of said saw assembly relative to said feeder path, said topper assembly configured to reduce the height of said flow of said wood chips such that said flow of wood chips does not tend to extend into said shaft interference zone, . . .”

Bateman does not disclose or describe any structure that is identical to the topper assembly recited in claim 1, or the method step of positioning such a topper assembly as recited in claim 68. The Examiner compares the feedwheel slide system (13) in *Bateman* to the topper assembly, noting that the *Bateman* slide system (13) “levels the feedwheel (14) to inhibit tilting of the feedwheel (14) thus inherently reducing the height of said flow”

Regardless of whether the slide system (13) might affect the height of a flow of wood chips, the slide system (13) in *Bateman* does not disclose the topper assembly in as complete detail as recited in claim 1 or 68, nor does it describe the topper assembly as arranged. In comparison to the topper assembly recited in claim 1 above, the slide system (13) in *Bateman* is not “positioned *proximate* said feeder path.” The slide system (13) as shown in Figure 1 is positioned above the feedwheel (14), far away from the flow of wood chips on the conveyor (12) below. Second, because of its location far above from the flow, the slide system (13) in *Bateman* is not “located *upstream* of said saw assembly relative to said feeder path.”

In re Application of Arasmith
Application No. 10/650,118
Amendment and Response to First Office Action
Page 36

Third and finally, the slide system (13) in *Bateman* does not reduce the height of a flow of wood chips “such that said flow of wood chips does not tend to extend into said shaft interference zone.” The slide system (13) as described in *Bateman* provides “automatic leveling of the feedwheel [14] if it begins to bind.” (Col. 5, lines 36-37). No mention is made of interference with the feedwheel shaft (un-numbered in Figure 1) or of any area or zone near the feedwheel shaft. Moreover, *Bateman* does not disclose or suggest any structure or element for controlling the flow of wood chips in relation to the feedwheel shaft.

Because the slide system (13) in *Bateman* does not disclose the topper assembly in as complete detail, or as arranged, in claim 1 or claim 68, the rejection is unsupported by the cited art and should be withdrawn.

Dependent claim 13 has been amended to depend from new claim 80, which recites allowable subject matter.

With regard to dependent claims 2 and 3, the *Bateman* reference does not disclose every element recited in independent claim 1 and, therefore, cannot anticipate these dependent claims. Similarly, with regard to dependent claim 69, the *Bateman* reference does not disclose every element recited in independent claim 68 and, therefore, cannot anticipate dependent claim 69. Accordingly, the rejection of dependent claims 2, 3, and 69 is not supported by the cited art and should be withdrawn.

Claim Rejections – 35 U.S.C. § 103(a)

Claim 4: The Examiner rejected dependent claim 4 under Section 103(a) on the grounds that the invention as claimed is obvious and unpatentable over *Bateman* in view of U.S. Patent 3,585,761 issued to *Hughes*. A *prima facie* case of obviousness requires that: (1) the prior art references teach or suggest all of the features of the claimed invention; (2) there is some suggestion or motivation to modify or combine the prior art references; and, (3) there is a reasonable expectation of success in combining the prior art references. MPEP § 2142; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

In re Application of Arasmith
Application No. 10/650,118
Amendment and Response to First Office Action
Page 37

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness." MPEP § 2142; *see also, In re Geiger*, 815 F.2d 686, 690 (Fed. Cir. 1987).

Claim 4 depends from independent claim 1. Because the rejection of claim 4 does not address how or why the features of claim 1 might be obvious, the rejection does not meet the initial burden of stating a *prima facie* case of obviousness and it should be withdrawn.

Claims 14, 19, 20, 23, 31, 35, 38, 46, 74, and 77 stand rejected under Section 103(a) on the grounds that the invention as claimed is obvious and unpatentable over *Bateman* in view of U.S. Patent 5,505,393 issued to *Serban, et al.* Claims 38 and 46 have been canceled. All the other claims in this group have been amended to depend from independent claims that recite allowable subject matter.

CONCLUSION

After entry of the requested amendment, claims 1-23, 25-37, 68-75, and 77-92 are pending in the application.

The following claims are in condition for immediate allowance: 6-23, 25-37, 71-75, and 77-92.

In light of this amendment and the remarks presented, the Applicant respectfully submits that all the claims of the application are patentable and allowable.

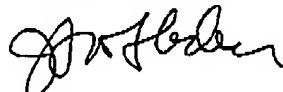
The undersigned is available at (404) 881-7821 if the Examiner has any questions or requests that may be resolved by telephone in order to expedite the examination of this application.

The Applicant submits herewith a Petition and Fee for Extension of Time. The Applicant does not believe any request for extension of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. In the event, however, that additional extensions of time are necessary to allow the consideration of this paper, such

In re Application of Arasmith
Application No. 10/650,118
Amendment and Response to First Office Action
Page 38

extensions are hereby petitioned-for under 37 CFR § 1.136(a) and any fee required therefor
(including fees for net addition of claims) is hereby authorized to be charged to Deposit Account
No. 16-0605.

Respectfully submitted,

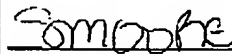


J. Scott Anderson
Registration No. 48,563

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Atlanta Office (404) 881-7000
Fax (404) 881-7777

CERTIFICATE OF FAX TRANSMISSION

I hereby certify that this paper is being transmitted by facsimile
to (571) 273-8300 at the U.S. Patent and Trademark Office on
this, the 15th day of December, 2005.


Shana Moore

ATL01/12089499v1

In re Application of Arasmith
Application No. 10/650,118
Amendment and Response to First Office Action
Page 39

APPENDIX A

Copy of the Second Preliminary Amendment
(filed on or about December 4, 2003)

RECEIVED
CENTRAL FAX CENTER

DEC 15 2005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/650,118

Confirmation No. 5876

Applicant : Arasmith

Filed : August 26, 2003

Title : WOOD-REDUCING APPARATUS WITH
CONTINUAL FEEDER ASSEMBLY

Art Unit : 3725

Examiner : _____

Docket No. : 043505-262883

Customer No. : 00826

December 4, 2003

Mail Stop Non-Fee Amendment
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

SECOND PRELIMINARY AMENDMENT
37 C.F.R. § 1.115

Sir:

Please enter this Preliminary Amendment before calculating the claims fee and amend the above-identified application as follows:

Amendments to the Specification begin on page 2 of this paper.

Application No. 10/650,118
Second Preliminary Amendment

AMENDMENTS TO THE SPECIFICATION

On page 1, please insert the following heading and paragraph:

"CROSS REFERENCE TO RELATED APPLICATIONS"

"This application claims the benefit and priority of the U.S. Provisional Application bearing Serial No. 60/406,022, filed August 26, 2002, entitled "Improved Wood Reducing Apparatus Including Slotted Paddle Wheel Feed Drum," which is incorporated herein by reference in its entirety."

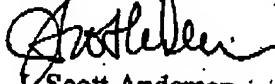
Application No. 10/650,118
Second Preliminary Amendment

CONCLUSION

The undersigned is available at (404) 881-7821 if the Examiner has any questions or requests that may be resolved by telephone in order to expedite the examination of this application.

The Applicants do not believe any request for extension of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. In the event, however, that additional extensions of time are necessary to allow the consideration of this paper, such extensions are hereby petitioned-for under 37 CFR § 1.136(a) and any fee required therefor (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



J. Scott Anderson

Registration No. 48,563

Customer No. 00826

ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Atlanta (404) 881-7000
Fax (404) 881-7777

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on this, the 4th day of December, 2003.


Shana Moore